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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,630	01/18/2001	James H. Goethel	L-F / 180DV	8472

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WOOD, HERRON & EVANS, LLP
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CINCINNATI, OH 45202

EXAMINER

HAYES, MICHAEL J

ART UNIT	PAPER NUMBER
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3763

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/764,630

Applicant(s)

GOETHEL ET AL.

Examiner

Michael J. Hayes

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6 and 8-13 is/are pending in the application.
- 4a) Of the above claim(s) 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6 and 8-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 February 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Newly submitted claim 13 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claim 13 recites a rearward extension with a knurled interior cavity, whereas the claims originally examined on the merits recite an extension that is enveloped by a coupling mechanism. Prosecution has continued on a species whereby the rearward extension of the plunger is enveloped by a coupling mechanism. Applicants' new claim 13 is a distinct species whereby the rearward extension has a knurled interior cavity into which a coupling mechanism is inserted. Original claim 7 did not have a knurled interior cavity, but rather was a knurled extension (like current species) with a cavity.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 13 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

This application contains claim 13 drawn to an invention nonelected with traverse in papers received 4/13/2005. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 3763

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-6, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Nightingale (US Patent No. 3747479). Nightingale discloses a syringe capable of mounting to an injector, including a barrel, plunger with a rearwardly facing drive ram engaging coupling element 72 that is knurled, a discharge tip, a conical front wall, syringe mating sections including annular flange, and an interior cavity within the coupling element 72. While a handle extends out of the barrel, the coupling element 72 does not extend out of the barrel in at least one position of the plunger. The area adapted to be within an area enveloped by a coupling mechanism (i.e., the knurled area) exhibits no discontinuity in area. See fig. 7. Knurls are defined to be a series of ridges or grooves.

Claims 1, 3-6, 8-11 are rejected under 35 U.S.C. 102(b) as being anticipated by REILLY (US Patent No. 4,677,980). Reilly discloses an injector, including a barrel, plunger with a rearwardly facing drive ram engaging coupling element 156 that is knurled with a series of ridges or grooves, a discharge tip, a conical front wall, syringe mating sections including annular flange, a moveable faceplate 14' being rotatable to lock the syringe in an arrangement with the injector, and mating sections 132 to align with the injector. See figs. 2 and 17. Re claim 8, the claim does not recite a knurl, but rather no discontinuities. Fig. 16 of Reilly shows a rearward extension having a latch 152a, but showing no discontinuities because the cross-section diameters would not be of much greater diameter than an adjacent cross-section.

Response to Arguments

Applicants argue that Nightingale does not disclose a drive ram, an extension adapted to be within an area enveloped by a coupling. Examiner points out that Applicants do not positively recite a drive ram in claims 1 and 12. The examiner disagrees because the extension from the plunger does have this capability due to its elongated structure. Applicant has not positively recited the coupling mechanism in claims 1, 3-6, and 12.

Applicants argue that enveloping the rearward extension with a coupling mechanism would destroy the reference and not meet the claim limitations. The examiner disagrees and points out that there is a space between the rearward extension and the barrel for a coupling mechanism.

With respect to claim 12 Nightingale Applicant argues that Nightingale discloses a discontinuity along its length. The examiner notes that though there is a discontinuity, this discontinuity is not within an area capable of being enveloped by a coupling mechanism.

In claims 1 and 12 Applicant recites structure “within an area enveloped by a coupling mechanism.” This claim limitation is construed as requiring the specific structure in some portion of the area enveloped by a coupling mechanism. This is distinguished from a limitation reciting within the area enveloped by a coupling mechanism, which requires the specific structure within the total area enveloped.

Applicants generally argue that Reilly does not disclose a knurled extension and the raised ridges are used in a different manner than Applicants’ raised ridges. The examiner maintains the rejection because Applicants have not established a specific definition in the specification as filed, and the common definition of knurl is “a protuberance, as a knob or knot,”

Art Unit: 3763

or “one of a series of small ridges.” (Webster’s II New Riverside University Dictionary, 1994).

Applicants use of their device in a different manner than the prior art does not carry patentable weight. The prior art discloses raised ridges and all structure recited in the claims.

Applicants argue that Reilly shows discontinuity in cross-sections. However, Applicants point out on pg. 17 of remarks received 4/13/05 that discontinuity in adjacent cross-sections means a cross section of much greater diameter than an adjacent cross-section. Reilly does not show much greater diameters in adjacent cross-sections.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

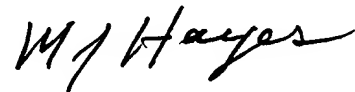
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Hayes at (571) 272-4959. The examiner can usually be

Art Unit: 3763

reached Monday -Thursday, 7:00-4:30, and on alternate Fridays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Lucchesi, can be contacted at (571) 272-4977. The fax number for submitting official papers is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mjh
21 July 2005

A handwritten signature in black ink, appearing to read "M J Hayes", written in a cursive style.

MICHAEL J. HAYES
PRIMARY EXAMINER